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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,902	10/08/2003	John M. Cuckler	5490-000350	6373
27572	7590	06/05/2006	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			SWIGER III, JAMES L	
			ART UNIT	PAPER NUMBER

3733

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/680,902	<b>Applicant(s)</b> CUCKLER ET AL.	
	<b>Examiner</b> James L. Swiger	<b>Art Unit</b> 3733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 17-25 and 34-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10, 16 and 26-33 is/are rejected.
- 7) ☒ Claim(s) 5, 6 and 11-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/8/04; 4/20/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 17-25 and 34-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/31/2006.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, and 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Bastian et al. (US 5,769,854). Bastian et al. disclose a bone cutting instrument comprising a guide (32) that is removable attachable to bone, a rotatable mill (30) that is attachable to the guide and is pivotable at the point of attachment (86) and within an opening (80), wherein it is capable of lateral adjustment relative to the opening and is capable of being laterally affixed while in multiple planes along the track/rotation point. The opening is also substantially box-shaped (see end of mill portion 70), has a driven end (92), as well as a cutting portion (60). Due to the rotation, the mill may be in a first position or a second position (Figs. 2 and 5) laterally constrained relative to the opening. The mill is also capable of a sequence of positions as it rotates, and the final position is

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influenced and is determined by the wall (82) of the guide where the mill may rest upon in the final position. The final position is capable of being perpendicular. The apparatus also has affixation pins (54), to secure the cutting guide in place (Col. 3, lines 31-35). Bastian et al. further teach a bone-attachment flange (40) that is substantially parallel to the base with two guiding sides (see Fig. 5).

***Claim Rejections - 35 USC § 103***

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 7, 9-10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastian et al. '854 in view of Coleman (US 5,591,207). Bastian et al. disclose the claimed invention except for a rod with a groove or truncated grooves to prevent lateral sliding, or a bore. Coleman discloses a device that teaches a rod (200) having truncated grooves (202) to allow the rod to be set at certain locations (see Col. 6, lines 60-67), and also a bore (136) capable of use in securing purposes (121; Col. 6, lines 5-33). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Bastian et al. having at least a rod

with truncated grooves and a bore in view of Coleman to aid in fixation and placement of the mill in use of the device.

Claims 4, 8, and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastian et al. '854 in view of Dietz et al. (US 5,653,714). Bastian et al. disclose the claimed invention except for the capability of the mill to slide laterally relative to the mill in either the first or second position. Dietz et al. teach a cutting guide that allows for lateral sliding along a rod (28) and see Fig. 1, that would be capable of interfacing with a mill portion (see Fig. 7) and in a first (Fig. 7) and second position (Fig. 8) that allows the device to be securely oriented in a multitude of positions, preventing the need for multiple cutting apparatuses. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Bastian et al. having at least the capability of lateral movement along a rod in view of Dietz et al. to allow for optimal orientation of the mill in relation to the cutting device.

#### ***Allowable Subject Matter***

Claims 5-6 and 11-15 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-


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5557. The examiner can normally be reached on Monday through Friday, 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLS

 5/28/06

  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER